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**OFFICE OF PETITIONS**

In re Application of  
Gallia, et al.  
Application No. 10/035,606  
Filing Date: 28 December, 2001  
Attorney Docket No. TI-32942

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This is a decision on the (renewed) petition filed on 8 April, 2005, to revive the instant application 37 C.F.R. §1.137(b) as having been abandoned due to unintentional delay.

For the reasons set forth below, the petition under 37 C.F.R. §1.137(b) **GRANTED**.

**NOTE:** **Although Petitioner was alerted by the Office in the 11 February, 2005, decision that his statement of unintentional delay failed to track the regulatory language, his most recent filing continues with that deficiency. As noted below, that language is being read into Petitioner's filing and Petitioner must notify the Office is such a reading is inconsistent with factual events.**

**BACKGROUND**

The record reflects that:

- Petitioner failed to reply timely and properly to the non-final Office action mailed on 26

September, 2003, with reply due absent extension of time on or before Monday 29 December, 2003 (the Office having been closed 26 December);

- the Application went abandoned after midnight 26 December, 2003;
- the Office mailed a Notice of Abandonment on 18 May, 2004;
- the original petition was dismissed on 11 February, 2005, because it was filed (on 2 February, 2005) with fee, and an incomplete statement of unintentional delay (Petitioner was cautioned to use the Office form for the petition or track the language of the regulation) and neither the 29 November, 2004, nor the 2 February, 2005, contained a reply to the 26 September, 2003, Office action;
- the instant submission provides a reply, however, the petition again fails to track the regulatory language.

**Therefore, the instant petition is read to include the statement by Petitioner Peter K. McLarty (Reg. No. 44,923) that "the entire delay from the due date of the reply until the filing of a grantable petition was unintentional" and Petitioner bears the professional responsibility and duty of candor to the Office to notify the Office if this reading is inconsistent with factual events.**

Thus, Petitioner is considered to have satisfied the requirements of the regulation.

#### STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).<sup>1</sup>

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority. The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for

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<sup>1</sup> 35 U.S.C. §133 provides:

**35 U.S.C. §133 Time for prosecuting application.**

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

the reply now to be accepted on petition.<sup>2</sup>

Delays in responding properly raise the question whether delays are unavoidable.<sup>3</sup> Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).<sup>4</sup> And the Petitioner must be diligent in attending to the matter.<sup>5</sup> Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.<sup>6</sup>))

#### Allegations as to Unintentional Delay

A grantable petition under 37 C.F.R. §1.137(b) requires a petition, fee, statement of unintentional delay, reply, and a terminal disclaimer and fee if appropriate.

As indicated above, Petitioner is considered to have satisfied the requirements of the regulation.

#### CONCLUSION

The record (including the petitions filed on 29 November, 2004, and 2 February and 8 April, 2005) does not necessitate a finding that the delay between midnight 26 December, 2003 (date of abandonment), and 8 April, 2005 (date of filing of grantable petition), was not unintentional.

Rather, the Patent and Trademark Office is relying in this matter on duty of candor and good faith of Petitioners' Counsel Peter K. McLarty (Reg. No. 44,923) when accepting Petitioners'

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<sup>2</sup> Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

<sup>3</sup> See: *Changes to Patent Practice and Procedure; Final Rule Notice*, 62 Fed. Reg. at 53158-59 (October 10, 1997), 1203 Off. Gaz. Pat. Office at 86-87 (October 21, 1997).

<sup>4</sup> See: *In re Application of G*, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

<sup>5</sup> See: *Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment*, 1124 Off. Gaz. Pat. Office 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 Off. Gaz. Pat. Office *supra*.

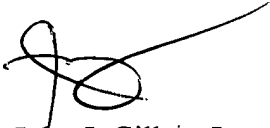
<sup>6</sup> Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

representation that the delay in filing the response was unintentional.<sup>7</sup>

The petition under 37 C.F.R. §1.137(b) is **granted**.

The application is released to Technology Center 2800 for further processing in due course.

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3214.



John J. Gillon, Jr.  
Senior Attorney  
Office of Petitions

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<sup>7</sup> See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing the statement required by 37 C.F.R. §1.137(b) to the Patent and Trademark Office).